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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/992,959	11/16/2001	Don Roderick Donovan	8628R	6652

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EXAMINER

SHAH, AMEE A

ART UNIT PAPER NUMBER

3625

DATE MAILED: 06/15/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/992,959	Applicant(s) DONOVAN ET AL.	
	Examiner Amea A. Shah	Art Unit 3625	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 May 2005.
- 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-21, 36 and 37 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-21, 36, 37 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 02 May 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

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DETAILED ACTION

Claims 1-21, 36 and 37 are pending in this action.

Response to Amendment

Applicant's amendment, filed May 5, 2005, is acknowledged and entered. The new drawings have been accepted. Claims 1, 2, 13 and 14 have been amended. Claims 22-35 have been withdrawn. Claims 36 and 37 have been added.

The amendments to the specification are objected to based on the following informalities: (1) in line 1 of the amended first paragraph, "is a continuation-in-part patent..." should read --is a continuation-in-part of patent...--; and (2) in lines 2-3 of amended first paragraph, "and International Application..." should read --and a continuation-in-part of International Application...--.

Replacement drawings 28-33 and 35-43 are acknowledged, entered, and accepted.

Priority

Applicant has not complied with one or more conditions for receiving the benefit of an earlier filing date under 35 U.S.C. 120 as follows:

The later-filed application must be an application for a patent for an invention which is also disclosed in the prior application (the parent or original nonprovisional application or provisional application); the disclosure of the invention in the parent application and in the later-filed application must be sufficient to comply with the requirements of the first paragraph of 35

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U.S.C. 112. See *Transco Products, Inc. v. Performance Contracting, Inc.*, 38 F.3d 551, 32 USPQ2d 1077 (Fed. Cir. 1994).

The prior applications, number 09/389,933, filed September 3, 1999, and international application number PCT/US01/21773, filed July 10, 2001, from which this application claims benefit as a continuation-in-part, do not adequately support the claims. In particular, neither application number 09/389,933 nor application number PCT/US01/21773 discloses synthesizing the first custom-combined and customized personal care product in the retail environment in accordance with the instructions, nor does either disclose providing the first personal care product at the retail environment to the consumer before the consumer leaves the retail environment, as recited by claim 1.

The prior application, provisional application number 60/217,672, filed July 10, 2000, from which this application claims benefit as a continuation-in-part, does not adequately support the claims. In particular, application number 60/217,672 does not disclose: (1) the preference data being representative of expressed physiological preferences of a consumer; (2) synthesizing the first custom-combined and customized personal care product in the retail environment in accordance with the instructions; nor (3) providing the first personal care product at the retail environment to the consumer before the consumer leaves the retail environment, as recited by claim 1.

Therefore, the effective filing date is November 16, 2001.

Response to Arguments

Applicant's arguments filed May 5, 2005, (hereinafter referred to as "Remarks") regarding the amended claims have been fully considered but they are not persuasive.

In response to applicant's argument that the Wilmott et al. reference fails to show certain features of applicant's invention (Remarks, page 12, ¶2), it is noted that the features upon which applicant relies (i.e., "fanciful images and psychological information about the consumer that convey a mood or a feeling to help associate a personal care product with the mood or feeling and thus include subjective factors in generating consumer-specified and computer-readable preference data using a user interface of a host computer in the retail environment") are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). Furthermore, examiner responds that Wilmott et al. does teach a computer-implemented method that includes the use of images and psychological information about the consumer (Figs. X1-X12 and col. 6, line 15 through col. 7, line 20), as discussed below and in the previous office action.

Claim Rejections - 35 U.S.C. § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claim 37 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter that was not described in

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the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Claim 37 contains the limitation of “information selected from the group consisting of ... fantasy personality...” (Remarks, page 9, claim 37, line 3). The examiner reviewed the specification in full, and at page 34, line 16, and page 40, line 7, found references to fantasy locations, but could not find any references or definitions of fantasy personality so that one of ordinary skill in the art would understand what was meant.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-21 are rejected under 35 U.S.C. 102(e) as being anticipated by Wilmott et al. (Pat. No. 6,782,307 B2).

Referring to claim 1: Wilmott et al. discloses a computer implemented method executed on one or more computers for synthesizing and distributing custom-combined and customized personal care products in a retail environment (see Abstract), comprising:

- generating consumer-specified and computer-readable preference data using a user interface of a host computer in the retail environment, (col. 6, lines 16-31)

the preference data being representative of expressed psychological and physiological preferences of a consumer with regard to personal care (Figs. X1-X12, col. 5, lines 23-25 and col. 6, line 22 through col. 7, line 20 – note that the psychological preferences include how the skin feels on an average day and the physiological preferences include skin type), wherein the generating comprises presenting one or more images using the user interface based on the preference data for selection by the consumer, the one or more images being associated with the personal care product (Figs. X1-X12);

- in response to the preference data, generating instructions with the host computer for reproducibly synthesizing a first custom-combined and customized personal care product in a format perceivable and understandable by humans (col. 9, lines 41-64);
- synthesizing the first custom-combined and customized personal care product in the retail environment in accordance with the instructions (col. 9, lines 41-64); and
- providing the first personal care product at the retail environment to the consumer before the consumer leaves the retail environment (col. 9, lines 41-64).

Referring to claim 2: Wilmott et al. further discloses the method of claim 1 wherein generating the preference data comprises employing a graphical user interface at the host computer to record responses by the consumer to a series of psychological and physiological

questions which are generated by the host computer while the host computer is executing the computer-implemented method (Figs. X1-X12).

Referring to claim 3: Wilmott et al. further discloses the method of claim 2 wherein either of the consumer and a consultant employs the graphical user interface to record the responses (col. 2, line 65 through col. 3, line 15 – note that the consultant is the attendant at the kiosk/point-of-sale).

Referring to claim 4: Wilmott et al. further discloses the method of claim 2 wherein the graphical user interface is generated by either of a stand-alone computing device and a networked computing device (col. 9, lines 41-64).

Referring to claim 5: Wilmott et al. also discloses the method of claim 2 further comprising employing the graphical user interface to retrieve previously generated data which is stored at a host computer corresponding to the consumer (col. 3, lines 16-35 – note that the host computer is the server).

Referring to claim 6: Wilmott et al. further discloses the method of claim 5 wherein the previously generated data comprises at least one of identification data representing the consumer, and commercial behavior data representing previous commercial activity by the consumer (col. 3, lines 16-35).

Referring to claim 7: Wilmott et al. further discloses the method of claim 1 wherein generating the instructions comprises any of providing the instructions in a graphical user interface, printing the instructions, and providing an audio representation of the instructions (col. 9, lines 41-64).

Referring to claim 8: Wilmott et al. further discloses the method of claim 1 wherein synthesizing the first personal care product comprises manually combining predetermined amounts of at least two personal care product components according to the instructions (col. 8, line 52 through col. 9, line 30, and col. 8, lines 41-64).

Referring to claim 9: Wilmott et al. further discloses the method of claim 8 wherein the predetermined amounts are provided via a manually operated dispensing system (col. 8, lines 52-58, and col. 9, lines 41-64).

Referring to claim 10: Wilmott et al. further discloses the method of claim 8 wherein the predetermined amounts are provided in previously measured increments (Figs. 2 and 3, col. 9, lines 1-11).

Referring to claim 11: Wilmott et al. further discloses the method of claim 1 wherein providing the first personal care product to the consumer comprises placing the first personal care product in a container, the method further comprising generating customized labeling for the container (col. 8, line 52 through col. 9, lines 30).

Referring to claim 12: Wilmott et al. further discloses the method of claim 1 wherein providing the first personal care product to the consumer comprises providing the first personal care product to the consumer in a sample size container (col. 8, line 52 through col. 9, line 30).

Referring to claim 13: Wilmott et al. also discloses the method of claim 12 further comprising:

- transmitting the instructions from the host computer to a receiving computer at a manufacturing facility (Figs. 3 and 4, col. 7, lines 38-58 and col. 8, line 52 through col. 9, line 65 – note that the transmittal is through the server and/or Internet);
- synthesizing the first personal care product at the manufacturing facility using the instructions (Figs. 3 and 4, col. 7, line 59 through col. 8, line 8, and col. 8, line 52 through col. 9, line 65);
- placing the first personal care product in a second container larger than the sample size container at the manufacturing facility (col. 8, line 52 through col. 9, line 65); and
- sending the second container to either of an address designated by the consumer, and the retail environment (col. 8, lines 27-33 and col. 8, line 52 through col. 9, line 65).

Referring to claim 14: Wilmott et al. also discloses the method of claim 1 further comprising storing the instructions at a host computer for future synthesis of the first personal care product (col. 3, lines 16-34).

Referring to claim 15: Wilmott et al. further discloses the method of claim 14 wherein storing the instructions comprises either of electronically storing instruction data representative of the instructions and storing a paper copy of the instructions (col. 8, line 52 through col. 9, line 65).

Referring to claim 16: Wilmott et al. also discloses the method of claim 14 further comprising synthesizing an additional amount of the first personal care product in response to a request from the consumer in accordance with the stored instructions (col. 8, line 52 through col. 9, line 65).

Referring to claim 17: Wilmott et al. further discloses the method of claim 1 wherein the first personal care product comprises a fragrance, the method further comprising identifying a first fragrance with reference to a first portion of the preference data, and identifying a second fragrance with reference to the first fragrance and a second portion of the preference data (col. 14, lines 52-61).

Referring to claim 18: Wilmott et al. further discloses the method of claim 1 wherein the first personal care product comprises a final formulation comprising a plurality of components,

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the method further comprising combining less than all of the components to synthesize an intermediate formulation, and providing a sample of the intermediate formulation to the consumer (col. 9, lines 41-64).

Referring to claim 19: Wilmott et al. further discloses the method of claim 1 wherein the first personal care product comprises any of a fragrance, a cosmetic product, a skin care product, and a hair care product (Fig. X3-A, Abstract, and col. 2, lines 45-51).

Referring to claim 20: Wilmott et al. further discloses the method of claim 18 wherein the final formulation comprises any of body wash, body lotion, hand creme, eye treatment, facial moisturizer, facial cleanser, facial balancer, shampoo, conditioner, body scrub, face mask, and face scrub (Fig. X3-A, Abstract, and col. 2, lines 45-51).

Referring to claim 21: Wilmott et al. discloses a personal care product synthesized according to the method of claim 1 (Abstract).

Referring to claim 36: Wilmott et al. further discloses the method of claim 1 wherein the generating comprises obtaining information comprising psychological and physiological information about the consumer, the information being associated with the personal care product (Figs. X1-X12, col. 3, lines 35-42, and col. 6, line 16 through col. 7, line 19).

Claim Rejections - 35 U.S.C. § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 37 is rejected under 35 U.S.C. 103(a) as being unpatentable over Wilmott et al. in view of Mascarenhas (US Pub. No. 2002/0029162 A1).

Referring to claim 37: Wilmott et al. discloses the method of claim 36, as discussed above, but does not expressly show wherein the psychological information comprises information selected from the group consisting of color preference, style preference, lifestyle preference, life stage, attitude, desired style, fantasy location, fantasy personality and combinations thereof. As analyzed above, Wilmott et al. shows obtaining information comprising psychological information such as how the skin feels on any given day.

However, this difference is only found in the non-functional descriptive material and is not functionally involved in the generating step recited. The obtaining of information would be performed in the same manner regardless of whether the information is related to psychological preferences, such as how the skin feels, the preferred colors or fantasy locations. The non-functional descriptive material will not distinguish the claimed invention from the prior art in terms of patentability. *See In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); and *In re Lowrey*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time of the invention to obtain information regardless of whether it was related to psychological information, such as how a person considered his/her skin to feel, the person's lifestyle, or fantasy locations, because such information does not functionally relate to the information obtaining step and also because the subjective interpretation of the information does not patentably distinguish the claimed invention.

Moreover, Mascarenhas, in the same filed of endeavor of e-shopping, discloses a system and method for creating classification patterns for end users to conduct custom searches for information about products, including wherein the psychological information comprises information selected from the group consisting of color preference, style preference, lifestyle preference, life stage, attitude, desired style, fantasy location, fantasy personality and combinations thereof (Fig. 1, page 5, ¶0069, pages 7-8, ¶¶0095-0113, and Table II – note that color preference is color test, style preference is design taste test, lifestyle preference is whether user is a loner (Index AG), or a team player (Index TP), life stage is life satisfaction test, attitude is life satisfaction test and personality, desired style is design taste test, fantasy location is recreation/travel test, and fantasy personality is personality test).

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to have modified the system of Wilmott et al. to include the teachings of Mascarenhas to allow for the psychological information to comprise of information selected from the group consisting of color preference, style preference, lifestyle preference, life stage, attitude, desired style, fantasy location, fantasy personality and combinations thereof. Doing so would provide

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for a more efficient, effective and targeted understanding of customers' desires so that a better-customized and more satisfactory product can be made, as suggested by Mascarenhas (page 1, ¶¶0009-0011).

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure: (1) Bartholomew et al., Patent No. 6,412,658 B1, disclosing a custom cosmetic powder dispensing method a system, particularly one employed at a point of sale, for the custom selection, design, blending, mixing or packaging of a body powder, and more particularly a cosmetic powder color, effect or both (*see* columns 3-7 and 10-13); and (2) Giacchetti et al, US Pub. No. 2003/0065525 A1, disclosing a system and method for providing beauty guidance based on physical and psychological profile information about the user (*see* Figs. 2-4 and pages 2-6).

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

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however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Amee A. Shah whose telephone number is 571-272-8116. The examiner can normally be reached on Mon.-Fri. 7:00 am - 3:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wynn W. Coggins can be reached on 571-272-7159. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

AAS

June 10, 2005


Y.C. Garf
Primary Examiner.